

RECEIVED
CENTRAL FAX CENTER

AUG 01 2006

REMARKS

Applicants and the undersigned are most grateful for the time and effort accorded the instant application by the Examiner.

Upon entry of the present amendment Claims 1-9 will be all of the claims pending for the Examiner's consideration.

Claims 1-9 have been amended by the instant Amendment. Applicants respectfully submit that no new matter has been added by the present amendment. Support for the amendment can be found generally throughout the text. Moreover, Applicants intend no change in the breadth of the claims by the changes made by this amendment. It should be noted this amendment is not in acquiescence of the Office's position on the allowability of the claims, but made merely to expedite prosecution.

It is respectfully submitted that the presently claimed embodiment of the invention is patentably distinct over the cited prior art; therefore, the Office is respectfully requested to reconsider and withdraw the rejections presented in the outstanding Office Action in light of the following remarks.

35 USC 102(b) Rejections (Martin and Hester, Jr.)

Claims 1-5 stand rejected under 35 U.S.C. 102(b) as being anticipated by Martin, U.S. Patent No. 4,720,566, or Hester, Jr., U.S. Patent No. 4,009,175. Applicants respectfully traverse these rejections.

As best understood, Martin relates to a "[m]ethod and composition for inhibiting acrylonitrile polymerization." (Title) Whereas Hester, Jr., appears to disclose "1-[(aminoxy)-methyl]-6-substituted-4H-s-triazole[4,3-a][1,4]benzodiazepines, intermediates, and the processes of production thereof." (Col. 2, lines 1-4)

Both Martin and Hester, Jr. stand in stark contrast to the present invention, which, broadly stated, relates to anti-skinning agents for use in oxidatively drying paints

Mo-7105D

- 5 -

and coatings. Claim 1 to the invention sets forth a “[p]rocess for preventing the skinning of a coating composition comprising: adding an anti-skinning agent... to the coating composition.” (Claim 1)

As the Examiner is aware, at the very least, “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under construction.” (W.L. Gore & Associates, Inc. v. Garlock, 721 F.2d 1540, 1554 (Fed. Cir. 1983); see also *In re Marshall*, 198 U.S.P.Q. 344, 346 (C.C.P.A. 1978)).

Applicants’ submit that since neither Martin nor Hester, Jr. teach, or even suggest, *inter alia*, the addition of an anti-skinning agent to a coating composition, thereby providing anti-skinning prevention, the references fail to anticipate the presently claimed invention. The rejections should therefore be withdrawn at this juncture.

35 USC 102(b) and/or 103(a) Rejections (Small)

Claims 1-5 stand rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Small, U.S. Patent No. 5,981,454. Applicants respectfully traverse these rejections.

As best understood, Small relates to semiconductor wafer production and accordingly provides “[a] composition for the removal of chemical residues from metal or dielectric surfaces or for chemical mechanical polishing of a copper surface...” (Abstract). The chemical composition appears to include a mono-, di-, or tri-functional organic acid and an amine buffering agent (Abstract). Thus, Small discloses a method for post-etching residue cleaning of a substrate during wafer production.

In contrast to Small stands the present invention, which as explained above, in at least one embodiment, relates to the prevention of the unintentional “skinning” of paints and coatings that can occur in oxidatively drying paints and coatings when they are exposed to oxygen. Accordingly, as was also indicated above, Claims 1-5 are directed

toward a "[p]rocess for preventing the skinning of a coating composition comprising: adding an anti-skinning agent... to the coating composition." (Claim 1)

Clearly, Small fails to teach the process of Claims 1-5 and therefore cannot anticipate the presently claimed invention since all of the presently claimed elements are not expressly or inherently disclosed.

In addition, it is well-settled law that to establish a *prima facie* case of obviousness, the USPTO must satisfy all of the following requirements: (1) the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references, *ProMold v. Great Lakes Plastics*, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996); (2) the proposed modification must have had a reasonable expectation of success, as determined from the vantage point of one of ordinary skill in the art at the time the invention was made, *Amgen v. Chugai Pharmaceutical Co.* 18 USPQ 2d 1016, 1023 (Fed Cir, 1991), *cert. denied* 502 U.S. 856 (1991); and (3) the prior art reference or combination of references must teach or suggest all of the limitations of the claims, *In re Wilson*, 165 USPQ 494, 496, (CCPA 1970).

The failure of Small to teach all of the presently claimed limitations of the invention precludes the present obviousness rejections. Moreover, the skilled artisan would neither expect the successful use of the Small invention as an anti-skinning process nor would the artisan be motivated to make the significant modifications to the Small invention necessary to use the same as a process for anti-skinning, if such modifications were even possible, because, for one reason, there is no indication that the contemplated chemistry of Small could be extended beyond the semiconductor industry.

Applicants respectfully submit the Small reference neither anticipates the presently claimed invention nor renders the same obvious. The withdrawal of the present rejections based on Small is hereby requested.

35 USC 103(a) Rejections (Link et al., Figge et al.(WO Pub.), and Derwent Abstract)

Claims 1-9 stand rejected under 35 U.S.C. 103(a) as being obvious over Link et al. ("Link"), U.S. Patent No. 5,985,018, or Figge et al. ("Figge"), WO 0011090, both references individually in view of Derwent English Language Abstract, ACC No. 1968-43058Q/196800 of DE 1519103 ("Derwent"). Applicants respectfully traverse these rejections for the following reasons.

As best understood, Link relates to "[c]oating compositions containing oxidatively drying binders and anti-skinning agents..." (Abstract) Link discloses anti-skinning agent mixtures comprising a compound of formula Ia or Ib admixed with a compound of formula II or III. Similarly, Figge appears to disclose diketones used, preferably, in combination with a pyroazole or imidazole based compound. The Office opines that either teaching discloses the presently claimed compounds of formula II. The Office further believes that the teachings provided by Link or Figge, in combination with Derwent, which appears to disclose the use of N,N-dialkylated hydroxylamine as anti-skinning agents, results in the presently claimed invention's obviousness. The Applicants however respectfully disagree.

Link appears to teach "anti-skinning agent mixtures containing the anti-skinning agents of formula Ia or Ib in admixture with compounds corresponding to formula (II)." (Col. 2, lines 44-54). Thus Link fails to teach or suggest to one skilled in the art the use of the compounds of formula (II) alone or in combination with other anti-skinning agents except for those as set forth in formulae Ia and Ib. Similarly, Derwent appears to disclose the use of a single N,N-dialkylated hydroxylamines anti-skinning agent. Similarly, Figge suggests the preferred method is a diketone in combination with a pyroazole or imidazole.

Mo-7105D

- 8 -

The combination of these references fails to suggest, *inter alia*, an anti-skinning method using a composition including a compound corresponding to HO-NR1R2 in combination with a compound corresponding to either R3-CO-CH-CO-R4 or O=CR5R6. Furthermore, the references themselves fail to provide a motivation for their combination. The motivation for the combination is only gained through the impermissible hindsight application of the present disclosure. As explained in the Applicants' specification, heretofore, the use of many anti-skinning compounds yielded undesirable results; moreover, in light of these undesirable results, one skilled in the art would not have had a reasonable expectation that their combination would successfully result in the presently claimed process.

In view of the foregoing, it is respectfully requested that the obviousness rejections should also be withdrawn.

In summary, it is respectfully submitted that the instant application, including Claims 1-9, is presently in condition for allowance. Notice to the effect is earnestly solicited. If there are any further issues in this application, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

By 

Nicanor A. Köhncke
Attorney for Applicants
Reg. No. 57,348

August 1, 2006

LANXESS Corporation
Law & Intellectual Property Department
111 RIDC Park West Drive
Pittsburgh, Pennsylvania 15205-9741
(412) 809-2234
FACSIMILE PHONE NUMBER:
(412) 809-1054

\\sr\\S:\\Law Shared\\SHARED\\NK\\PATENTS\\7105D\\Amendment (August 2006).doc

Mo-7105D

- 9 -